

The opinion in support of the decision being entered today
is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ERIC SEAN PARHAM, BRIAN E. WILLIAMS,
ANTHONY JOHN PAUL CAREW, and
ROBERT WHITCHER

Appeal 2007-1781
Application 09/685,274
Technology Center 2600

Decided: September 26, 2007

Before JOSEPH L. DIXON, ANITA PELLMAN GROSS, and
ST. JOHN COURTENAY III, *Administrative Patent Judges*.
DIXON, *Administrative Patent Judge*.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the
Examiner's Final Rejection of claims 1-20. We have jurisdiction under
35 U.S.C. § 6(b).

We AFFIRM.

Rather than reiterate the conflicting viewpoints advanced by the Examiner and the Appellants regarding the above-noted rejection, we make reference to the Examiner's Answer (mailed Nov. 15, 2006) for the reasoning in support of the rejections, and to Appellants' Brief (filed Aug. 21, 2006) and Reply Brief (filed Jan. 16, 2007) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to Appellants' Specification and claims, to the applied prior art references, and to the respective positions articulated by Appellants and the Examiner. As a consequence of our review, we make the determinations that follow.

35 U.S.C. § 112, SECOND PARAGRAPH

Claims 3, 9-11, and 14-20 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particular point out and distinctly claim the subject matter which applicants regard as the invention. The Examiner maintains that dependent claim 3 is unclear as to what is meant by "provide the signaling information in a media gateway and call session control format to a Class 5 softswitch" because a Class 5 softswitch is neither defined in the specification nor well known as a term in the art (Answer 3). The Examiner finds similar fault in claims 9-11 and 14-20 (Answer 3-4).

Appellants have provided a printout of an article from SUPERCOMM 2000 "TalkingNets to Implement telecom technologies' Flexible Softswitch Technology Within its Next-Generation Network", dated June 6, 2000,

which is four months before Appellants' filing date. Appellants maintain that the term Class 5 softswitch was a well-known term in the art to those skilled in the relevant art (Br. 4). The Examiner maintains that the SUPERCOMM 2000 article is "very general, short and does not teach Class 5 softswitch, but discuss soft switches as an alternative to Class 5 switches and contain no in-depth information on the Class 5 softswitch implementation." (Answer 7). Additionally, the Examiner maintains that mentioning the concept of soft switches in an article is not clearly sufficient to define a Class 5 softswitch because the article contains mostly marketing/sales information for TalkingNets Co. and was not intended to define a Class five soft switch or the Class five soft switch signaling format (Answer 7).

While we agree with the Examiner that the article from SUPERCOMM 2000 is general and does not contain in-depth information on Class 5 softswitches, we do find that the term was known to those skilled in the telecommunications art, and those skilled in the relevant art would have been able to discern the metes and bounds of the invention claimed in dependent claim 3. Additionally, we do not find it to be a requirement that Appellants provide an express definition of each claim limitation so long as those skilled in the art would have been able to determine the metes and bounds of the claimed invention with respect to other devices in the marketplace. Here, we find the use of the claimed terminology "Class 5 soft switch" to be broad rather than indefinite, and we will not sustain the rejection of claims 3, 9-11, and 14-20 under 35 U.S.C. § 112, second paragraph.

35 U.S.C. § 103

With respect to the Examiner's rejection under 35 U.S.C. § 103(a) over the combination of Smyk in view of DSL forum, we agree with the Examiner's rejection as set forth in the Answer at pages 4-5 and the motivation to combine the teachings of DSL forum with recently developed broadband loop emulation service (BLES). Smyk teaches a flexible system that will instruct the network to handle calls differently depending on whether the service should be based on a Class 5 switch or the service manager (SM). (Smyk, col. 5, ll. 14-16). Smyk teaches that a next-generation network (NGN) is a packet-based network that employs new control management and signaling techniques to provide narrowband voice telephony services and broadband multimedia services. (Smyk, col. 1, ll. 22-26). Smyk teaches in a first mode of operation that the NGN simulates a digital local loop to allow local services to be offered to all NGN customers via Class 5 switching systems. In this mode, the NGN is transparent to both the customer and the Class 5 switching system. This mode of operation is referred to herein as virtual local loop (VLL) mode. (Smyk, col. 3, l. 63-col. 4, l. 1).

Here, we find that Smyk teaches a gateway operable to receive signaling information in a media gateway and call session control format, the gateway further operable to convert the media gateway and the call session control format to a broad band loop emulation service signaling protocol. We further find that Smyk teaches the gateway is operable to provide tone generation and detection capabilities pursuant to the signaling information as recited in independent claim 1. Smyk teaches a Class 5 switch that will provide a dial tone to customer 420 and collect dial digits.

The call is routed to the terminating party 28 using traditional PSTN call signaling and transmission capabilities (Smyk, col. 6, ll. 54-57). While Smyk does not disclose the use of BLES, Smyk does disclose the use of virtual phones using packetized local loop facilities (e.g., DSL) to connect to a local loop gateway. The packetized local loop network communicates with Class 5 switches through a local gateway (Smyk, column 3, lines 23-28).

DSL forum is directed to digital subscriber loop (DSL) technology and broadband loop emulation service (BLES). Additionally, DSL forum discusses that Class 5 services include switches which include soft switches (DSL forum 20, section 6.3.3.1. Regular telephony features). (See Annex B, which is not part of the reference as supplied by the Examiner.)

We disagree with Appellants' contention that the Examiner has not set forth a sufficient motivation for the combination. We find the Examiner has set forth sufficient motivation and suggestion in the combination of Smyk and DSL forum such that the skilled artisan would have combined the relevant teachings (Br. 6-7).

Appellants' main contention is that Smyk has no disclosure with respect to BLES service signaling protocol and is not capable of performing the media gateway and call session format conversion to BLES as provided in the claimed invention. Appellants further contend that DSL forum does not disclose a gateway that converts a media gateway and call session format to a BLES signaling protocol and has no disclosure with respect to the media gateway and call session format. Appellants contend that the structure from the combination of the two teachings would still lack an ability to convert a media gateway and call session format to a broadband loop emulation

service signaling protocol while also providing tone generation and detection as required by the claimed invention (Br. 8).

We do not agree with Appellants' position, and we find that the combination of Smyk and DSL forum would have fairly suggested the invention as recited in independent claim 1. We find the Examiner's statement of motivation to combine and the suggestion for combinability with respect to new standards (such as BLES being essential for devices from different manufacturers to work together on a network), would have been persuasive to one skilled in the art (Answer 8). Therefore, we will sustain the rejection of independent claim 1 and dependent claims 3 and 9-11, which have not been separately argued by Appellants. We note that Appellants argue claims 3 and 9-11 in the Brief at pages 8-9 but do not include the required heading for a separate grouping of these claims. Therefore, we include these claims with independent claim 1.

While Appellants argue that Smyk is directed to a Class 5 switch and has no teachings with respect to a Class 5 softswitch. As noted above, we find DSL forum teaches the use of Class 5 switches including the use of softswitches. Therefore, we find it would have been obvious to one of ordinary skill in the art to have implemented the combination of Smyk and DSL forum with a Class 5 softswitch. We further find that those skilled in the art would have appreciated the difference between a conventional Class 5 switch and a Class 5 softswitch and would have recognized the required interfacing since DSL forum expressly mentions the use thereof.

With respect to independent claim 14, Appellants rely upon the same argument as advanced with respect to independent claim 1 and dependent claim 3, which we did not find persuasive above (Br. 10-11). Therefore, we

Appeal 2007-1981
Application 09/685,274

do not find this argument persuasive, and we will sustain the rejection of independent claim 14 and dependent claims 15-20, which have not been separately argued by Appellants.

CONCLUSION

To summarize, we have reversed the rejection of claims 3, 9-11, and 14-20 under 35 U.S.C. § 112, second paragraph. We have sustained the rejection of claims 1-20 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED

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